

REMARKS/ARGUMENTS

Claims 1-44 are currently pending in this application.

The Office Action of August 25, 2006 has required restriction to one of the following Groups under 35 U.S.C. §121:

- Group I: Claims 1-15, 22, and 24-34, drawn to methods for amplifying one or more nucleic acids, classified in class 435, subclass 91.2;
- Group II: Claims 16-21, drawn to a library comprising a plurality of nucleic acid molecules immobilized to a bead, classified in class 536, subclass 23.1;
- Group III: Claims 34-38, drawn to methods for producing a clonal population of proteins, classified in class 435, subclass 68.1;
- Group IV: Claims 23 and 39-44, drawn to an emulsion comprising microreactors, and a kit comprising nucleic acid capture beads, and emulsion oil, and one or more emulsion stabilizers, classified in class 435, subclass 287.2.

Applicants hereby elect Group I, corresponding to instant Claims 1-15, 22, and 24-34, with traverse, for further prosecution on the merits.

The MPEP sets forth two requirements for restriction to be proper. First, the claims must independent or distinct. Second, if the search and examination of all the claims in an application can be made without serious burden, the Examiner must examine them on the merits, even though they include claims to independent or distinct inventions (MPEP §803; emphasis added).

The Office Action contends that a search of all the Groups I-IV cannot be made without serious burden on the Examiner because the Groups have acquired a separate status in the art because of their recognized divergent subject matter. However, Applicants note that each of Groups I, III, and IV are classified in class 435, which implies that the subject-matter of the claims encompassed by these Groups share features and characteristics that warrant common classification. A search for the subject-matter of Group I would necessarily be co-extensive with a search for the subject-matter of Group III, as well as with Group IV.

The Office Action further contends that Groups I and II; Groups II and III; Groups I and IV; and Groups III and IV are each related to each other as product and process of use. In particular, the Office Action alleges that the subject-matter of Groups I and II can be shown to be distinct if the process for using the product as claimed can be practiced with another materially

different product, and/or the product as claimed can be used in a materially different process of using that product (MPEP §806.05(h)). Practicing the methods encompassed by Group I would necessarily result in the library comprising a plurality of nucleic acid molecules immobilized to a bead, as encompassed by Group II. Further, in view of the fact that Group I is commonly classified in class 435 with Groups III and IV, Applicants respectfully submit that the claims, as originally filed and presented herein, represent a web of knowledge and continuity of effort that merits examination as a single application. Restriction has not been shown to be proper and would result in unnecessary expenditures incurred by both Applicants and the USPTO.

Reconsideration and withdrawal of the restriction requirement are respectfully requested.

CONCLUSION

Examination on the merits of the instant case is respectfully requested. If there are any questions regarding this Response, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,

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